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OFFICE OF PETITIONS

In re Application of	:	
William Whitted	:	
Patent Number: 8,011,742	:	DECISION ON
Issue Date: 09/06/2011	:	APPLICATION FOR
Application No. 10/675233	:	PATENT TERM ADJUSTMENT
Filing or 371(c) Date: 09/29/2003	:	
Attorney Docket Number:	:	
16113-1313001 / GP-144-05	:	

This is a decision on the petition filed on November 7, 2011, requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand two hundred fifty-three (1253) days. The petition is properly treated under 37 CFR 1.705(d).

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by one thousand two hundred fifty-three (1253) days is **DISMISSED**.

Patentee avers that the Office erred in calculating a reduction of 67 days in connection with the filing of a reply to a non-final Office action, mailed December 12, 2005, three months and 67 days after the reply was due, on Thursday, May 18, 2006. Patentee asserts that because the due date for the reply, March 12, 2006, fell over a weekend, the three (3) month date for the reply should be calculated from Monday, March 13, 2006, and the period of reduction should be 66 days, and not 67 days, as intended by 35 U.S.C. 154(b)(2)(C)(ii). Applicant references 37 CFR 1.704(b).

Patentee also asserts that that the Office erred in calculating a reduction of 100 days in connection with the filing of a reply to a final Office action, mailed August 4, 2006, three months and 100 days after the reply was due, on Monday, February 12, 2007. Patentee asserts that because the due date for the reply, November 4, 2006, fell over a weekend, the three (3) month date for the reply should be calculated from Monday, November 6, 2006, and the period of reduction should be 98 days, and not 100 days, as intended by 35 U.S.C. 154(b)(2)(C)(ii). Applicant references 37 CFR 1.704(b).

Patentee also asserts that the Office erred in calculating a reduction of 90 days in connection with the filing of a reply to a final Office action, mailed November 23, 2007, three months and 90 days after the reply was due, on Friday, May 23, 2008. Patentee asserts that because the due date for the reply, February 23, 2008, fell over a weekend, the three (3) month date for the reply should be calculated from Monday, February 25, 2008, and the period of reduction should be 88 days, and not 90 days, as intended by 35 U.S.C. 154(b)(2)(C)(ii). Applicant references 37 CFR 1.704(b).

Finally, Patentee asserts that the Office erred in subtracting from the "B" Delay period time that was not consumed by continued examination. Patentees filed, inter alia, Requests for Continued Examination ("RCE"), on February 12, 2007. This Office mailed a Notice of Allowance and Issue Fee Due on July 13, 2011. Patentees request an additional fifty-six (56) days of patent term adjustment in the period beginning on the date that the Notice of Allowance and Issue Fee Due was mailed, and ending on the date the patent issued, September 6, 2011. Patentees aver that with the mailing of the Notice of Allowance on July 13, 2011, the Office closed examination on the present application on that date, and no continued examination took place in the 56-day period from the mailing date of the Notice of Allowance and Issue Fee Due, to the issuance of the patent. Accordingly, Patentees aver that 56 days of B Delay should have been included in the period of delay accorded by the Director, and that the "B Delay" for issuance of the patent beyond three years from filing is 191 days, instead of 135 days.

Patentee's arguments have been carefully considered. Regarding the reduction of 67 days in connection with the non-final Office action, mailed December 12, 2005, Office records confirm that the reply to the Office action was filed on Thursday, May 18, 2006. 35 U.S.C. 21(b) provides that "[w]hen the day, or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or a Federal holiday within the District of Columbia, the action may be taken, or fee paid, on the next succeeding secular or business day. Here, the day or last day for filing a reply to the Office action (i.e. May 12, 2006), was neither a Saturday, Sunday, nor a Federal holiday within the District of Columbia. Further to this, as stated in ArQule, 35 U.S.C. § 21(b) applies to any action an applicant can take, including timeliness of an applicant's response to a PTO request. ArQule at p.10. (Emphasis added). Applicant filed a reply on Thursday, May 18, 2006, and Wednesday, May 17, 2006, was also not a Saturday, Sunday, or a Federal holiday within the District of Columbia. The Office properly calculated the period of reduction beginning on the day after the date that is three months after the date of mailing or transmission of the Office action, March 13, 2006, and ending on the date applicant filed the reply, May 18, 2006, and the period of reduction properly calculated at 67 days.

Regarding the reduction of 100 days in connection with the filing of a reply to a final Office action, mailed August 4, 2006, three months and 100 days after the reply was due, on Monday, February 12, 2007, 35 U.S.C. 21(b) provides that "[w]hen the day, or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or a Federal holiday within the District of Columbia, the action may be taken, or fee paid, on the next succeeding secular or business day. Here, last day for filing the reply fell on

Monday, February 4, 2007, which was neither a “Saturday, Sunday, or a Federal holiday within the District of Columbia.” As such, 35 U.S.C. 21(b) does not apply, and the period of reduction is properly calculated at 100 days.

Regarding the reduction of 90 days, Office records confirm that a final Office action was mailed November 23, 2007, and that the reply to the Office action was filed on Friday, May 23, 2008. Here, the day, or the last day, for filing the reply (i.e. May 23, 2008), was neither a weekend nor a Federal holiday within the District of Columbia. Further to this, as stated in ArQule, 35 U.S.C. § 21(b) applies to any action an applicant can take, including timeliness of an applicant’s response to a PTO request. ArQule at p.10. (Emphasis added). Here, applicant filed a reply on Friday, May 23, 2008. The Office properly calculated the period of reduction beginning on the day after the date that is three months after the date of mailing or transmission of the Office action, November 24, 2007, and ending on the date applicant filed the reply, May 23, 2008, and the period of reduction properly calculated at 90 days.

Regarding the “B delay,” counting the period of time excluded from the “B delay” for the filing of a request for continued examination under 35 U.S.C. 132(b), from the date on which the request for continued examination is filed to the date the patent is issued is proper. Patentee does not dispute that time consumed by continued examination of an application under 35 U.S.C. 132(b) is properly excluded and that the calculation of the excluded period begins on the date of filing of the request for continued examination. At issue is what further processing or examination beyond the date of filing of the request for continued examination is not any time consumed by continued examination of the application under 35 U.S.C. 132(b). The USPTO indicated in September of 2000 in the final rule to implement the patent term adjustment provisions of the AIPA that once a request for continued examination under 35 U.S.C. 132(b) and 37 CFR 1.114 is filed in an application, any further processing or examination of the application, including granting of a patent, is by virtue of the continued examination given to the application under 35 U.S.C. 132(b) and CFR 1.114. See Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term, 65 Fed. Reg. 56366, 56376 (Sept. 18, 2000) (response to comment 8). Thus, the excluded period begins with the filing of the request for continued examination and ends with the issuance of the patent.

Patentee’s argument that the period of time after the issuance of a notice of allowance on a request for continued examination is not “any time consumed by continued examination requested by the applicant under section 132(b)” within the meaning of 35 U.S.C. 154(b)(1)(B)(i) is not availing. This limitation is not supported by the statutory language. Garcia v. United States, 469 U.S. 70, 75 (1984) (“only the most extraordinary showing of contrary intentions from [legislative history] would justify a limitation on the ‘plain meaning’ of the statutory language”). BP Am. Prod. Co. v. Burton, 549 U.S. 84, 91 (2006) (“Unless otherwise defined, statutory terms are generally interpreted in accordance with their ordinary meaning”). The statute provides for a guarantee of no more than 3-year application pendency, by providing for an adjustment in the patent term:

First, "Subject to the limitations of paragraph (2)," means that the limitations of paragraph 2 apply to this paragraph's adjustment of patent term. That is, the day-to-day extension of patent term for pendency beyond the 3 year period is restricted as follows: 1) "B delay" cannot accrue for days of "A delay" that overlap, 2) the patent term cannot be extended beyond disclaimed term, and 3) the period of adjustment, including accrued "B delay," will be reduced for applicant delay.

Second, "if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States," meaning that the condition must first occur that the issuance of an original patent (35 U.S.C. 153), not merely the issuance of a notice of allowance, is delayed due to the Office's failure to issue a patent (sign and record a patent grant in the name of the United States), not merely mail a notice of allowance, within 3 years after the actual filing date of the application in the United States. This provision gives the Office a three-year period to issue a patent (sign and record a patent grant in the name of the United States) after the application filing date before an adjustment will accrue for "B delay."

Third, "not including- (i) any time consumed by continued examination of the application requested by the applicant under section 132(b); (ii) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court; or (iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), meaning that the three-year period does not include "any time consumed by" or "any delay in processing," as specified in clauses (i)-(iii). This language correlates to 35 U.S.C. 154(b)(1)(A) which likewise provides the basis for determining the period given the Office to take the specified actions before an adjustment will accrue for "A delay" (e.g., extended for 1 day after the day after the period specified in clauses (i)-(iv)).

Furthermore, these clauses are interpreted using their ordinary meanings. Nonetheless, the context of the legislation should be considered. As stated in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008), because the clock for calculating the 20-year patent term begins to run on the filing date, and not on the day the patent is actually granted, some of the effective term of a patent is consumed by the time it takes to prosecute the application. To mitigate this effect, the statute, *inter alia*, grants adjustments of patent term whenever the patent prosecution takes more than three years, regardless of the reason. The time consumed by prosecution of the application includes every day the application is pending before the Office from the actual filing date of the application in the United States until the date of issuance of the patent. The time it takes to prosecute the application ends not with the mailing of the notice of allowance, but with the issuance of the patent.

Thus, not including “any time consumed by” means not including any days used to prosecute the application as specified in clauses (i)-(ii)¹. Clause (i) specifies “any time consumed by continued examination of the application requested by the applicant under section 132(b).” Clause (ii) specifies “any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court.” “Time” in the context of this legislation throughout refers to days. “Consumed by” means used by or used in the course of. *Websters Collegiate Dictionary*, (11th ed.). The “any” signifies that the days consumed by are “any” of the days in the pendency of the application, and not just days that occur after the application has been pending for 3 years. As such, “any time consumed by” refers to any days used in the course of 1) continued examination of the application under section 132(b)(the filing of a request for continued examination), 2) interference proceedings, 3) secrecy orders, and 4) appellate review. Thus, that 3-year period given to the Office to issue a patent before an adjustment will accrue for “B delay” does not include any days used in the course of or any time consumed by clauses (i)-(ii), including any time consumed by the filing of a request for continued examination.

Fourth, “the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued” meaning that the consequence of this failure is that after “the end of that 3-year period” an additional 1 day of patent term will accrue for each day that the application is pending until the day the patent is issued.

The “time consumed by” or used in the course of the continued examination of the application requested by the applicant under section 132(b) does not end until issuance of the patent. 35 U.S.C. 132(b) was enacted under the same title, the “American Inventors Protection Act of 1999,” as 35 U.S.C. 154(b). Section 4403 of the AIPA amended 35 U.S.C. § 132 to provide, at the request of the applicant, for continued examination of an application for a fee (request for continued examination or RCE practice), without requiring the applicant to file a continuing application under 37 CFR 1.53(b) or a continued prosecution application (CPA) under 37 CFR 1.53(d). Thus, clause (i) is different from clause (ii) in that clause (i) refers to an examination process whereas clause (ii) refers to time consumed by proceedings (interferences, secrecy orders and appeals) in an application.

By nature, the time used in the course of the examination process continues to issuance of the patent. The examination process involves examining the application to ascertain whether it appears that the applicant is entitled to a patent under the law. See 35 U.S.C. 131 (“[t]he Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the

¹ Clause (iii) provides for not including (iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued. It is noted that paragraph (3)(C) allows with an adequate showing by applicant for reinstatement of no more than 3 months of the patent term reduced for applicant delay in taking in excess of three months to respond.

Director shall issue a patent therefor"). If on examination it appears that the applicant is entitled to a patent, the USPTO issues a notice of allowance. See 35 U.S.C. 151 ("[i]f it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant"). If on examination it appears that the applicant is not entitled to a patent, the USPTO issues a notice (an Office action) stating the applicable rejection, objection, or other requirement, with the reasons therefor. See 35 U.S.C. 132 ("[w]henver, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application"). Neither the issuance of a notice of allowance nor the issuance of an Office action terminates the examination process. If after the issuance of an Office action under 35 U.S.C. 132 it subsequently appears that the applicant is entitled to a patent (e.g., in response to an argument or amendment by the applicant), the USPTO will issue a notice of allowance. Conversely, if after the issuance of a notice of allowance under 35 U.S.C. 151 it subsequently appears that the applicant is not entitled to a patent (e.g., in response to information provided by the applicant or uncovered by the USPTO), the USPTO will withdraw the application from issuance and issue an Office action under 35 U.S.C. 132 stating the applicable rejection, objection, or other requirement, with the reasons therefor.

As held in Blacklight Power, the USPTO's responsibility to issue a patent containing only patentable claims does not end with the issuance of a notice of allowance under 35 U.S.C. 151. See BlackLight Power, Inc. v. Rogan, 295 F.3d 1269, 1273 (Fed. Cir. 2002). Rather, if there is any substantial, reasonable ground within the knowledge or cognizance of the Director as to why an application should not issue, it is the USPTO's duty to refuse to issue the patent even if a notice of allowance has previously been issued for the application. See In re Drawbaugh, 9 App. D.C. 219, 240 (D.C. Cir 1896).

Moreover, the applicant continues to be engaged in the examination process after the mailing of the notice of allowance. 37 CFR 1.56 makes clear that the applicant has a duty to disclose information material to patentability as long as the application is pending before the USPTO (i.e., until a patent is granted or the application is abandoned). See 37 CFR 1.56(a) ("[t]he duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned"). 37 CFR 1.97 and 1.98 provide for the consideration of information submitted by the applicant after a notice of allowance has been mailed. See 37 CFR 1.97(d). In addition, 37 CFR 1.312 provides for the amendment of an application after a notice of allowance has been mailed. In fact, the request for examination procedures² permit the filing of a request for continued examination under 37 CFR 1.114 even after the issuance of a notice of allowance under 35 U.S.C. 151. See 37 CFR 1.114(a)(1).

As the examination process does not terminate with the mailing of the notice of allowance, the time consumed by continued examination requested by the applicant under section 132(b) does

² Thus, on occasion, even where a request for continued examination has already been filed and a notice of allowance issued pursuant to that request, applicant may file a further request for continued examination.

not terminate with the mailing of the notice of allowance. All the time the application is pending from the date of filing of the request for continued examination to the mailing of the notice of allowance through issuance of the patent is a consequence of the filing of the request for continued examination. Further action by the Office is pursuant to that request. Applicant has gotten further prosecution of the application without having to file a continuing application under 37 CFR 1.53(b).

All of the continued examination pursuant to the filing of the request by the applicant is properly excluded from the delay attributed to the Office. 35 U.S.C. 154(b)(1)(B)'s guarantee of a total application pendency of no more than three years provides for adjustment of the patent term for delay due to the Office's failure to issue the patent within three years, but does not include "any time consumed by continued examination requested by the applicant under 35 U.S.C. 132(b)." It is not necessary to mitigate the effect on the 20-year term to the extent that applicant has requested that the Office continue to examine the application via a request for continued examination, in lieu of, the filing of a continuing application under 37 CFR 1.53(b).

As the period from the filing date of the request for continued examination (RCE) to the issue date of the patent is not included in the "B" delay period, the over three year period begins on September 30, 2006, and ends on February 11, 2007, the day before the RCE, filed February 12, 2007, was filed, and is 135 days. See, 35 U.S.C. 154(b)(1)(B)(i).

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3232.

/DLW/

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